



Image
AP/37224

PTO/SB/21 (08-03)

Approved for use through 08/30/2003. OMB 0651-0031

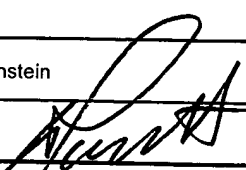
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/081, 095
	Filing Date	2/22/2002
	First Named Inventor	Loewenstein
	Art Unit	3722
	Examiner Name	Collins
Total Number of Pages in This Submission	Attorney Docket Number	Two sided cards

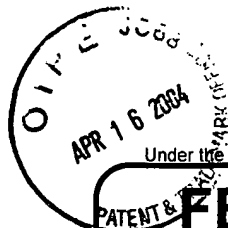
ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	David A. Loewenstein Reg No. 35,591
Signature	
Date	

CERTIFICATE OF TRANSMISSION/MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.	
Typed or printed name	David A. Loewenstein
Signature	
Date	4/14/04

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PATENT & TRADEMARK FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 165

Complete if Known

Application Number	10/081,095
Filing Date	2/22/2002
First Named Inventor	Loewenstein
Examiner Name	Collins
Art Unit	3722
Attorney Docket No.	Two-sided cards

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

Deposit Account Number
Deposit Account Name

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☐ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X	
Multiple Dependent	-3** =	X	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	165
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 165

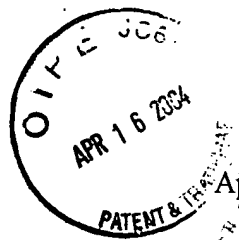
SUBMITTED BY

Name (Print/Type)	David A. Loewenstein	Registration No. (Attorney/Agent)	35,591	Telephone	914-937-4119
Signature		Date	4/19/04		

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Loewenstein
Serial No. : 10/081,095
Filed : 02/22/2002
Title : Cards and Card Games
Examiner : Collins
Art Unit : 3711

APPEAL BRIEF

I. REAL PARTY IN INTEREST

David A. Loewenstein

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

Claim 1 was rejected on the ground of anticipation in view of Silliman, Jr.

Claim 2 was rejected as obvious in view of the combination of Silliman, Jr.
and Hoyt.

Claims 3-5 were rejected as obvious in view of the combination of Silliman,
Jr. Hoyt and Stanton

Claim 13 was rejected as obvious in view of Silliman, Jr.

Claim 18 was rejected as obvious over Silliman, Jr. and Moody.

Claim 19 was rejected "as being method [sic] that is well known in the art."

Claim 20 was rejected “as being well known in the art.”

Claim 21 was rejected “as being a mere issue of intended use.”

Claim 22-24 was rejected as obvious in view of Silliman, Jr., Hoyt and Moody.

Claim 25 was rejected “as being well known in the art.”

IV. STATUS OF AMENDMENTS

Claim amendments were made after final rejection and were entered by the Examiner. The status of the claims is set forth in the attached Appendix.

V. SUMMARY OF INVENTION

This invention is an entirely new type of playing cards and games that use them that have particular (although not exclusive) application to video poker, either in a casino setting or on a personal computer. In the 500+ year history of playing cards, all cards have had common features; the card suit (hearts, diamonds, etc) and card value (King, Queen Jack, etc.) were presented together on one side and the other side had a non-descriptive back. One such ancient conventional deck of cards can be seen at www.metmuseum.org/collections/view1.asp?dep=7&full=1&item=1983%2E515%2E1%2D52.

The invention here splits the suit and the card value so that when the card is first dealt it displays only the suit -- and not the card value. (See Figure 1). After the player selects the card, it changes its appearance and displays both the suit and the card value and resembles a conventional card. (See Figure 1). Because the cards claimed in the application have no card backs, they cannot be dealt “face down” like conventional cards.

These new cards always have some information (e.g., the card's suit) displayed to the player.

The claimed cards provide players with additional information (i.e., the cards suit) that they otherwise would not have with conventional cards because they would be dealt face down. This innovation makes games more interesting, and would seem to make the game easier for the player to win. However, the games are subtly more complex and challenging than it first appears.

No card in the prior art has these innovative features, or anything close.

In addition to the innovative cards, Applicant has claimed methods to play a number of card games using them. Several method claims cover games where the cards are dealt in a diamond pattern with five cards on a side, three interior card and two common corner cards. Similar games, using conventional cards, are the subject of Applicant's co-pending applications (10/015,314 and 10/211,063) and have a unique combination of other features, such as:

- permitting the player to exchange cards to improve his hand, which provides the player with additional control over his hands and improves his chances for winning;
- having common or shared cards between hands, which makes for interesting and complex strategic decisions;
- showing the player more cards than in typical draw poker, giving the player more information for his decision; and
- the ability to play multiple hands with a minimum of dealt cards, which increases the difficulty to the player because although he is playing four, five-card

hands (which ordinarily would require 20 cards), these games use only 16 cards.

VI. ISSUES

A. Did the prior art disclose cards that when first dealt display only the card's suit?

B. Did Silliman Jr. ("Sillimna") or Stanton disclose cards that split the card suit and the card value so that when the cards were first dealt they displayed only the cards' suit?

C. Did the combination of the prior art disclose or suggest the claimed inventions so that the claimed inventions can be said to have been obvious?

VII. GROUPING CLAIMS

Claims 1 and 2 relate to the novel cards themselves.

The remaining claims relates to methods to play various games using the novel cards:

- Claims 3-4 and 22-25 relate to a game where the cards are dealt in a diamond pattern;
- Claims 5, 18 - 21 relates to a method to playing video poker in general using the novel cards;
- Claim 13 relates to playing poker or blackjack using the novel cards

ARGUMENT

THE INVENTIONS WERE NOT ANTICIPATED

It goes without saying that a claimed invention was not anticipated unless each claim element existed in the prior art exactly as in the pending claim. Moba v. Diamond Automation, 325 F.3d 1306, 1321 (Fed. Cir. 2003) (“Anticipation under 35 U.S.C. § 102 requires that a single prior art reference disclose each and every limitation of the claimed invention.”); In re King, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (“It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim”); RCA Corp. v. Applied Digital Data Sys., 730 F.2d 1440, 1444 (Fed. Cir. 1984) (“Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention.”).

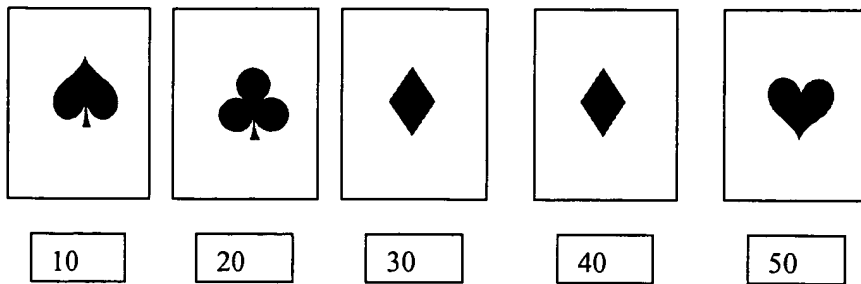
Here, the prior art unquestionably does not have a key limitation contained in all the claims -- displaying only the suit of the card when the card is first dealt.

CLAIM 1 WAS NOT ANTICIPATED

Claim 1 states (emphasis added):

“A method to play cards, where each card has a suit and a card value, when each card is dealt it displays the suit but not the card value, and when a player selects a card both the suit and card value are displayed.”

The following illustration shows how cards in the present invention look when they are first dealt. This corresponds to application Figure 1.



It is important to recognize that the cards shown above, and claimed in all the pending claims, do not display the card value (i.e., Ace, King, Queen, 10, etc.). This critical distinction alone suffices to distinguish the claimed inventions from the prior art. There is absolutely no prior art that separates the card suit and the card value, and displays the cards suit separately.

The Examiner's advisory action concluded: "[Silliman's] cards teach a value on one side and the suit and value on the other." Silliman never displays only the card suit. That alone distinguishes Silliman from the claimed inventions, and prevents Silliman from anticipating the claimed invention. This can easily be seen in Figures 1 to 6 of Silliman that show the fronts and backs of his cards. None of those Figures shows the suit alone as claimed in Claim 1 and as shown in Applicant's Figure 1.

The Examiner has misunderstood the claimed invention. Silliman is altogether different from the inventions at issue. Silliman discloses conventional playing cards (i.e., cards that have the suit and value together on one side and a non-descriptive card back). The only difference between Silliman and conventional cards is that in Silliman the card backs have the numbers 1 to 4.

The numbers on Silliman's card backs do not correspond in any way to the suits of the cards, or to the card value. To the extent the Examiner confuses Silliman numbers 1 to 4 with the Applicant's "card values", the discussion below explains why equating the two is incorrect.

Silliman's numbers, 1, 2, 3 and 4, correspond to card hands -- and are not card values as Applicant has claimed. The numbers on Silliman's card backs are to enable bridge players, for example, to duplicate each of the four player's hand so that the identical hands can be easily given to four new players so that the new players can replay the same hands. The cards can be easily re-dealt by just looking at the number on the card backs. Claim 1 of Silliman explains the reason for this is to permit players to "regroup [the cards] into several hands after being played and mingled together." After the first game was played and the cards were all mixed together, a dealer could redistribute the cards to another four players simply by looking at the numbers on the cards backs. Silliman would allow four players to play a card game, and four other players to play the identical four hands in a subsequent game to match their skill against the first four players. Silliman further explains (col. 1, lines 45-49): "The 13 cards of each [of the four] hand[s] are then numbered on the backs from 1 to 4 respectively as in Figs. 1 and 2, so that there shall be 13 cards bearing each number 1 to 4, inclusive."

If, as Examiner concluded, Silliman's cards had the card value on the back, then the numbering would run from 1 to 13 corresponding to the 13 values of conventional playing cards and not 1 to 4.

The intention of Silliman is to allow multiple groups of four players to start with identical card hands, to remove luck from the outcome of the games and to focus on

the players' skill. This enables players in a tournament to compete on equal footing because players start with the same hands.

In a tournament, any number of players could be give the cards identified with the number one on the card backs. The player who had the best result with the cards bearing the number one would be declared the winner of the tournament.

Silliman quite obviously has nothing whatsoever in common with the claimed invention. Silliman does not disclose or suggest in anyway cards that display only the suit when first dealt. And, nothing in Silliman suggests that the appearance of the cards changes after the player selects the cards as in Applicant's claimed invention.

Silliman did not anticipate the claimed invention, and it does not suggest anything that could render the invention obvious.

CLAIM 2 WAS NOT OBVIOUS

Claim 2 states:

“A deck of playing cards, or an electronic representation of playing cards where some of the cards have the suit on one side but not the card value and both the suit and card value on the other, and the remaining cards are conventional cards that display both the suit and card value on the same side of the card and display neither the suit nor card value on the other side.”

Because the Examiner misinterpreted Claim 1, she has also misinterpreted Claim 2. This led to the erroneous conclusion that Silliman disclosed limitations of Claim 2.

Claim 2 covers a deck of cards in which some of the cards use the novel design. It is intended to prevent unscrupulous copyists from putting a few conventional cards in a deck and trying to argue that the deck does not infringe.

Claim 2, like Claim 1, in relevant part states: “some of the cards have the suit on one side but not the card value and both the suit and card value on the other.” As explained above, Silliman does not have cards that have the suit on one side without the card value.

Moreover, unlike Silliman, Claim 2 allows for only part of a deck of cards to have the suit only on one side. Silliman only describes an entire deck of numbered cards, regardless of the meaning of the numbers. Having a deck only partially marked would not allow Silliman to accomplish his goal for dealing the entire deck to four players repetitively with the same hands.

Hoyt Did Not Anticipate or Render the Invention Obvious

Hoyt does not add anything. Hoyt does not disclose cards where the suit alone is displayed first and then both the suit and card value are displayed.

Hoyt discloses several unrelated things. One is a “Tic-Tac-Toe” card game using conventional cards where the cards are dealt in a 3 x 3 matrix. This configuration could be used to play blackjack or poker, but has nothing to do with Applicant’s invention. Although the Examiner is correct that Hoyt describes a poker game, he does so in the

context of conventional cards.

Hoyt's other embodiments use cards that have numerical values only – and no suits. In the embodiment of Figure 2, Hoyt has 60 cards divided into six groups made up of 10 cards each. (See page 3, paragraph “[0037]”).

Hoyt states:

“These cards do not necessarily need a suit indication (Club, Spade, Diamond or Heart) as found on cards from a standard playing deck of cards.” (See page 3 paragraph “[0037]”).

Claim 3, which covers this embodiment, shows Hoyt's cards have conventional backs, which Applicant's cards do not have:

“3. A deck of playing cards comprising a multiple number of playing cards, each card having a front side of the card and a back side of the card, said back side either containing a design or not containing a design, such that each of the multiple number of cards contains a back side which is similar to each of the other multiple number of cards, such that said multiple number of cards cannot be distinguished from the others by observing the back side of the card, said front side of each of said multiple number of playing cards contains an indication of quantity, said indication of quantity being between one and ten.

Plainly, Hoyt's cards are not the same or remotely similar to Applicant's novel deck.

Hoyt's card in Figure 3 is modeled after the number on a roulette wheel. (See paragraph “[0040]”). Cards are numbered from 1 to 36 with “0” or “00”. “These cards contain information similar to the information found on a roulette wheel.” (See Paragraph “[0040]”). Again, this has nothing in common with the claimed invention.

Claim 5, which covers this embodiment, again, makes it plain that Hoyt's cards have conventional card backs:

“5. A deck of playing cards comprising a multiple number of playing cards, each card having a front side of the card and a back side of the card, said back side either containing a design or not containing a design, such that each of the multiple

number of cards contains a back side which is similar to each of the other multiple number of cards, such that said multiple number of cards cannot be distinguished from the others by observing the back side of the card, said front side of each of said multiple number of playing cards contains a number, an indication of color, an indication of odd or even, and an indication of group.

Both the claims and specification demonstrate that Hoyt's cards do not resemble

Applicant's cards and do not suggest the method or games Applicant has claimed.

Combining the two (assuming *arguendo* that a motivation to combine existed¹) would not yield the claimed invention -- a critical limitation is missing from both references that cannot be derived from any other the prior art. Therefore, the combination of these two references cannot support the conclusion that the claimed invention would have been obvious to a person of ordinary skill in the art. In re Royka, 490 F.2d 981, 985 (CCPA 1974)(Rich J.)(All claim limitations must be in the prior art); see also MPEP § 2143.03 ("All Claim Limitations Must Be Taught or Suggested").

CLAIMS 3-5 and 25 WERE NOT OBVIOUS

The Examiner stated:

"[Silliman's] cards teach a value on one side and a suit on the other, but fail to explicitly teach his cards are dealt in the diamond shape.

Stanton discloses Improvements in and relating to Playing cards. Stanton teaches cards with indicia arranged into four suits on one side and values on the other side (page 1, lines 14-24, figures 1-4).

¹ An invention was not obvious unless there was some "teaching, suggestion or motivation" in the prior art to combine references. Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., 21 F.3d 1068, 1072 (Fed. Cir. 1994) ("[T]he prior art must provide a suggestion or motivation to make such a combination."); Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367 (Fed. Cir. 2002). Moreover, the "motivation to combine must be clear and particular, and it must be supported by actual evidence." Teleflex, Inc. v. Ficosa North America Corp., 299 F.3d 1313, 1334 (Fed. Cir. 2002).

In the November 28, 2003 Office Action, the Examiner also concluded:

“It would be obvious in view of Stanton to arrange the cards to add excitement to the game played by the players.”

Silliman

As explained above, Silliman does not disclose a card value separated from the card suit. In Silliman, both the card value and the suit are on the same side of the cards, and are always displayed together.

Stanton

Stanton, like Silliman, discloses a deck of cards that has marked card backs to allow the same four hands of cards to be dealt repetitively without the dealer seeing the face of the cards. Stanton explains that the backs of the cards are marked so “that they may be readily and accurately dealt or separated into hands, or sets, without the dealer seeing the face of any card.” (Page 2 lines 17-19).

Stanton, like Silliman, does not disclose cards that display the suit alone when first dealt.

Stanton’s idea, like Silliman’s, is to have four players begin the game with the identical hands; he explains that his cards have their backs marked so that “each player will commence on an equal basis or with an equal hand and the game will then become a game of skill instead of a game of chance as heretofore.” (Page 1 line 26-28). On page 2 of Stanton (The Complete Specification), he further explains his cards are intended to overcome a certain problem with conventional cards (lines 10 to 15):

“Under the present system the cards are shuffled and dealt indiscriminately and almost invariably the holder of the cards of the highest value succeeds in winning,

irrespective of skill or ability.

According to this invention I arrange the complete pack of cards *i.e.*, the four suits, into four groups or sets of 13.

Each group or set having cards of equal value made up of different suits . . .”

Stanton further states:

“the main object of the invention being to provide a pack or set of cards which can be dealt so that each player at the commencement of a hand or game will hold cards which are equal in value to the cards held by the other and respective players.”
(Page 1, lines 4-7).

In the November 28, 2003 Office Action, the Examiner has cited lines 14-24 and Figures 1 to 4 of Stanton. For clarity, Applicant has reproduced those lines below because they do not have any bearing whatsoever on Applicant’s invention:

“According to this invention, I arrange the complete set of cards *i.e.*, the four suits, into four sets each set having cards of equal value, and so mark, print, brand, denote or otherwise distinguish the four sets that, in dealing, each player will receive one of the sets of the cards. The distinguishing of the cards may be variously modified as desired, it may be done by printing the backs of the cards in different colours, by applying distinguishable advertisements, or by printing different designs, one on each set. In arranging say, an ordinary set or pack of playing cards each distinctive set will consist of the following cards, *viz*: Ace, ten six, and two (deuce) of one suit; king nine, and five of another suit; queen, eight and four of another suit, and knave [jack], seven and three of the last suit.”

The Figure in Stanton shows the card backs but does not show the suit or the card value. This means without question Stanton does not disclose cards that have the suit on one side and the suit and card value on the other side. Stanton merely has a mark on an otherwise non-descriptive back that permits cards to be grouped together easily.

Stanton’s cards were to be used in a game called whist, a game similar to bridge, where four players compete as two-sets of partners. Stanton observed that the winner of the game typically was the person who was dealt the best cards – not necessarily the best player. His solution was to start all four players with identical hands. That way,

the game would turn exclusively on skill, and luck would be removed from the equation. Obviously, dealing a conventional deck to four players to insure each had the same starting hands would be laborious. To overcome that problem, Stanton developed his deck that used a color code or some distinctive card back to facilitate dealing. With his deck, each player would receive the same hand, although with different suits, and apparently the players would not know which suits the other players had.

However, Stanton's cards are altogether different from Applicant's invention. Stanton's card's have a particular pattern on their back to enable the dealer to distribute identical hands to four players. Stanton's cards have four patterns on the backs - none of which provides the player any information about the suit or value of the card. Stanton did not separate the card value and suit and put the suit alone on one side of the card, as explained in Applicant's invention. Stanton, therefore did not anticipate, nor do his cards suggest Applicant's invention.

Assuming arguendo that there was some motivation to combine Stanton and Hoyt (with or without Silliman), and there is none, the combined cards would be an unusable mishmash of cards that were not at all the same as Applicant's cards or games. If, for example, these cards were combined, Stanton's conventional cards with a coded back and Hoyt's cards either numbers 1 to 10 or 1 to 36 (with "0" and "00"), the deck would have either 38, 52 or 60 cards of an unclear design. Would the cards have suits? Would they have coded backs? Would they have numbers 1 to 10 without suits, or would they be 52 cards with the suits and value on one side, as in conventional cards, and marked backs. In sum, the combined cards would not be Applicant's innovative design. In all events, the combined cards would still not have the innovative feature that only the suits

are displayed when the cards are first dealt.

In the November 28, 2003 Office Action, the Examiner stated that “[i]t would be obvious to deal cards in whatever shape that is desired since shape would constitute a design issue. Additionally, the dealing of cards in various shapes is well known in the art (e.g., *Memory* cards are dealt in the shape of a square, in the game of *Solitaire*, cards are ultimately dealt in the shape of a triangle.” Applicant is unfamiliar with “Memory” and the “Solitaire” game where cards are in the shape of a triangle.²

Applicant’s diamond-shaped game is not purely a “design issue.” Rather, it is: a novel arrangement of cards that enables an entirely new variation of poker with many new features. Specifically, it permits: multi-hand play, which is extremely popular in casinos; has common corner cards which itself adds challenging strategic decisions; permits players to exchange cards to improve their hands, which adds additional complex strategic decisions; is visually unique and should draw players in a crowded casino setting -- and has a unique deck of cards never before used. No prior art reference suggests this novel combination of features. Additionally, none of the prior art references has the added feature of using the novel claimed cards.

Applicant’s invention considered as a whole is drastically different from any cited prior art. Therefore, even if these references were combined (and there is no motivation to combine references in any case) the resulting game would not be the claimed invention. None of these references, Silliman, Stanton or Hoyt, discloses dealing cards in a

² “When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR 1.104(d)(2).” MPEP § 2144.03.

diamond shape, or exchanging cards, which further demonstrates that combining reference would not yield the claimed invention. See Royka, *supra*.

Although playing cards have existed for centuries, (see a medieval set of cards www.metmuseum.org/collections/view1.asp?dep=7&full=1&item=1983%2E515%2E1%2D52), and hundreds of patents exist related to cards and various card games, many of which have been cited by the Examiner, none is the same, similar, or provides any motivation whatsoever to develop Applicant's novel invention. Failure of others and long standing need are persuasive indicia of non-obviousness. See generally, WMS Gaming v. IGT, 184 F.3d 1339 (Fed. Cir. 1999).

CLAIM 13 WAS NOT OBVIOUS

In the November 28, 2003 Office Action, the Examiner stated:
“[Silliman's] cards teach a value on one side and suit and value on the other, but fail to explicitly teach cards with a non-descriptive back.”

For the same reasons as discussed above, Silliman does not disclose cards with the suit on one side separated from the card value on the other side. It simply is not there.

CLAIM 18 WAS NOT OBVIOUS

To arrive at her conclusion that Claim 18 was obvious, the Examiner combined Moody and Silliman.

In addition to the significant difference between the claimed invention and Silliman explained above, Silliman does not suggest any applicability to poker and Moody

does not disclose a game where the player selects from more than five cards to build a five card hand. Instead, Moody repeats identical five cards hands multiple times. In Moody's game, the cards are "duplicated" from one hand to another. (See col. 1, lines 22-24).

Moody does not disclose cards where the suit alone is displayed.

Therefore, combining Moody with Silliman will not yield Applicant's invention, or anything close to this novel game.

CLAIMS 19 -21 WERE NOT OBVIOUS

The Examiner concluded the following:

Claim 19 was obvious "as being method [sic] that is well known in the art."

Claim 20 was obvious "as being well known in the art"

Claim 21 was obvious "as being a mere issue of intended use."

Claim 19 states:

"A method of playing video poker comprising:

- (a) dealing cards from a deck of playing cards that have suits and a series of card values;
- (b) having the cards display the suit, but not the card value when dealt;
- (c) allowing a player to select one or more cards to form a poker hand;
- (d) after the player selects each card, displaying both the card value and suit of the card;
- (e) comparing the resulting hand to a paytable; and

(f) paying the player according to the payable

Claim 20 is dependant on Claim 19 and adds the limitation that some of the cards are conventional cards with non-descriptive backs (for the same reasons as described in Claim 2 above).

Claim 21 is dependant on Claim 19 and adds that the cards are dealt in a diamond shape.

As explained above, none of the prior art references disclose or suggest cards that “display the suit, but not the card value when first dealt.” This key distinction alone prevents the claims from being held obvious.

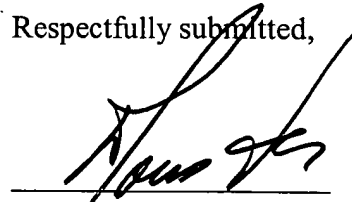
CLAIMS 22-24 WERE NOT OBVIOUS

The Examiner rejected Claims 22-24 as obvious in light of the combination of Silliman, Hoyt and Moody. For reasons, explained in detail above, this combination of unrelated card games does not result in the claimed invention, and therefore cannot lead to a determination that the claimed invention was obvious. Royka, supra. Moreover, by having the player use the suit information as part of the play, Applicant has changed the course of play to a new form of video poker.

CONCLUSION

For the foregoing reasons, Applicant believes his inventions were neither anticipated nor were obvious in view of the any cited prior art. Therefore, Applicant respectfully requests a favorable determination.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David A. Loewenstein', is written over a horizontal line.

Date: April 14, 2004

David A. Loewenstein
Reg. No. 35, 591
802 King Street
Rye Brook, NY 10573
(914) 937-4119

APPENDIX

1. A method to play cards, where, each card has a suit and a card value, when each card is dealt it displays the suit but not the card value, and when a player selects a card both the suit and card value are displayed.

2. A deck of playing cards, or an electronic representation of playing cards where some of the cards have the suit on one side but not the card value and both the suit and card value on the other, and the remaining cards are conventional cards that display both the suit and card value on the same side of the card and display neither the suit nor card value on the other side.

3. A method to play a video poker game where cards are dealt from a deck comprising cards that have four suits and a series of card values; the cards are dealt in a diamond pattern, each of the four sides of the diamond forming a five card poker hand with three interior cards and two corner cards where some or all of the cards display the suit, but not both the suit and card value when dealt; the player is allowed to exchange cards between hands; after the exchanges, both the suit and card value of the cards are displayed; each hand is then compared to a payable and the player is paid off according to the payable.

4. The method to play a video poker game of claim 3 where the corner cards are conventional cards dealt face down, the player is permitted to exchange some or all of the interior cards; after the exchange both the suit and card value of the interior cards are displayed; the corner cards are turned face-up, and the player is paid off according to the payable.

5. A method to play a video poker game where two or more hands of

cards are dealt from a deck that has cards with four suits and a series of card values, where some or all of the cards display the suit, but not both the suit and card value when dealt, one or more bets can be placed, the cards then display both the suit and card value, and the player is paid off according to a paytable.

13. A method to use playing cards, or an electronic representation of playing cards, for playing gambling card games like poker and blackjack where the cards have both suits and card values; when the cards are dealt the card's suit is displayed, but the card's value is not displayed; when a player selects a card both the card's value and the card's suit are displayed.

18. The method of claim 13 where more than 5 cards are dealt and the player is required to select a five card poker hand from the dealt cards.

19. A method of playing video poker comprising:

- (a) dealing cards from a deck of playing cards that have suits and a series of card values;
- (b) having the cards display the suit, but not the card value when dealt;
- (c) allowing a player to select one or more cards to form a poker hand;
- (d) after the player selects each card, displaying both the card value and suit of the card;
- (e) comparing the resulting hand to a paytable; and
- (f) paying the player according to the paytable.

20. The method of claim 19 where some of the cards are conventional

with non-descriptive backs.

21. The method of Claim 19, where cards are dealt in diamond pattern.

22. The method of Claim 13, where cards are dealt in diamond pattern to play a poker-type game and where each side of the diamond is a separate hand; and the player is permitted to exchange cards from one hand to another, after the exchange the cards are compared to a payable and the player is paid according to the payable.

23. The method of Claim 13, where cards are dealt in a diamond pattern and where each side of the diamond is a separate five card poker hand consisting of three interior cards and two corner cards; the corner cards are conventional cards dealt face down and are shared between adjacent hands; the player is given an opportunity to exchange interior cards between hands; after the exchange each hand is compared to the payable and the player is paid according to the payable.

24. The method of Claim 13, where cards are dealt in a diamond pattern, where each side of the diamond is a separate five card poker hand consisting of three interior cards and two corner cards, which are shared between adjacent hands; the interior cards are conventional cards dealt face up and the corner cards display only the suit; the player is given an opportunity to exchange interior cards between hands; after the card exchange, the corner cards change to show both the suit and card value; each hand is compared to the payable and the player is paid according to the payable.

25. The method of Claim 3 where the player is given the opportunity to exchange corner cards only.